

Notice of Allowability

Application No.

09/995,931

Examiner

Srirama Channavajjala

Applicant(s)

YU, PHILIP K.

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 3/14/06.
2. ☒ The allowed claim(s) is/are 19-22, 24, 27-29 [re-numbered as: 1-8].
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date 03172006.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 03172006.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

1. Claims 19,21,27-28 have been amended [3/14/2006].
2. Claims 26,31-38 have been cancelled [3/14/2006].
3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/14/2006 has been entered
4. It is noted that applicant filed RCE on 12/20/2005 is "improper RCE", see MPEP 706.07.
5. Claims 37-38 have been added [10/5/2005].
6. Claims 19-36 have been amended [10/5/2005].
7. Claims 1-18 have been cancelled [5/12/2005].
8. Claims 19-36 have been added [5/12/2005]
9. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/12/2005 has been entered and a non-final Office action mailed on 05/31/2005

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10. Examiner acknowledges applicant's amendment filed on 8/2/2004
11. In view of amending claims 7-8 [8/2/2004], the objection to claims 7-8 as set forth in the previous office action is hereby withdrawn.

Drawings

12. Applicant is hereby required to submit "**formal drawings**" fig 3-4, including changes required by the Examiner's Amendment attached with this office action.
13. The drawings filed on 11/28/2001 are acceptable for examination purpose

Information Disclosure Statement

14. The information disclosure statement filed on **8/2/2004** comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 has been considered, a copy of PTO-1449 is hereby enclosed with previous office action.

Priority

15. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged based on Provisional Application Number **60/253,490** filed on November 28, 2000

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Interview:

16. Applicant's Attorney Philip K Yu, Reg. No. 35,742 is thanked for the telephone interview on 17 March 2006. During that telephone interview Philip K Yu granted authorization to **amend claims 19,21,27,28, cancel 23,25,30** and amendment to the **specification** [U.S.Publication: 2002/0065808 A1] paragraphs [0058.1] and [0058.2], and amendment to the **drawing** fig 3, step 303, line 8; step 306, line 2; step 306, line 3; and fig 4, step 403, line 7; step 407, line 2.

EXAMINER'S AMENDMENT

17. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Philip K Yu, Reg. No. 35,742 on 17 March 2006.

The application has been amended as follows:

In the Specification [U.S.Publication: 2002/0065808 A1]

Please amend paragraphs [0058.1] and [0058.2]:

[0058.1] Reference is to Figure 3, where a simplified flow diagram of a second exemplary embodiment of the present invention is illustrated. The method of using the Internet to retrieve an article in electronic form from a printed publication, comprises:

- Block 301 – Preparing at least one article that is to be published in printed paper form for circulation by the publisher;
- Block 302 – Assigning, by the publisher, the article with one unique tag prior to printing the article in printed paper form for circulation by the publisher;
- Block 303 – Publishing in circulation, by the publisher, both of the one article and its corresponding unique tag in printed paper form with its corresponding tag being printed in physical proximity to the article, the publisher also providing retrieval information indicative of a web site, an e-mail address and a telephone number for retrieval;
- Block 304 – Storing, by the publisher, the article in an electronic database, the article being uniquely retrievable based on the corresponding unique tag;
- Block 305 – Connecting, by the publisher, the database to the Internet, where the database is a telecommunication gateway adapted to transmit the request through wireless and landline telephone network;
- Block 306 – Receiving, by the publisher, a request from an Internet client through one of the web site, the e-mail address and the telephone number indicated by said retrieval information, the request including the at least one tag and delivery information indicative of at least one of the client's telephone number and e-mail address, the tag having been previously observed by the client from the printed paper form in circulation, the client having previously registered at least one of the client's telephone number and the client's e-mail address with the publisher;
- Block 307 – The publisher authenticating the client based on at least one of the client's telephone number and the client's e-mail address indicated by the request;
- Block 308 – Retrieving by the publisher from the database to locate the article in electronic form matching the tag, upon authenticating the client's request;

Block 309 – Upon locating the article in electronic form from the database, the publisher electronically transmitting the article in electronic form to the client's email address, and

[0058.2] Reference is to Figure 4, where a simplified flow diagram of another exemplary embodiment of the present invention is illustrated. The method, which provides retrieval through an aggregator, comprises:

Block 401 – Preparing a plurality of articles to be published in printed paper form for circulation by a publisher;

Block 402 – Assigning, by the publisher, each of the articles to at least one unique tag prior to printing in printed paper form for circulation;

Block 403 – Publishing in circulation, by the publisher, each of the articles in printed paper form with its corresponding tag also printed in physical proximity to each of the articles, the publisher also providing retrieval information indicative of a web site, an e-mail address and a telephone number for retrieval from an aggregator;

Block 404 – Collecting the articles in portable electronic form;

Block 405 – Storing the articles in electronic database managed by the aggregator, each of the articles being uniquely retrievable based on the tag corresponding to each article;

Block 406 – Connecting, by the aggregator, the database to the Internet;

Block 407 – Receiving by the aggregator a request from an Internet client through any one of the web site, the e-mail address and the telephone number indicated by the retrieval information, the request specifying a tag and the Internet client's delivery means of either one of the Internet client's telephone number or e-mail address, the tag having been previously observed by the Internet client from the printed paper form in circulation, the client having previously registered at least one of the Internet client's telephone number and the e-mail address with the aggregator;

Block 408 – The aggregator authenticating the Internet client based on either one of the Internet client's telephone number and the Internet client's e-mail address indicated by the request;

Block 409 – Retrieving from database to locate the article in portable electronic form matching the at least one tag by the aggregator, upon authenticating the Internet client's request, and

Block 410 – Upon locating the article in electronic form, the aggregator electronically sending the article in portable electronic form to the Internet client based on the Internet client's delivery means.

Drawings

18. The following changes to the drawings **Figs 3-4** have been approved by the examiner and agreed upon by applicant:

In Figure 3:

In step 303, line 8, after "providing" add -- **"retrieval"**--

In step 306, line 2, after "telephone number" add -- **"indicated by the retrieval information"**—

In step 306, line 3, after "and" add -- **"delivery"**--.

In Figure 4:

In step 403, line 7, after "providing" add -- **"retrieval"**—

In step 407, line 2, after "telephone number" add -- **"of the retrieval information"**--.

In the Claims

19. (currently amended) A method of using the Internet to retrieve and handle at least one article in electronic form from a printed publication which has been printed in paper form by a publisher, comprising:

preparing at least one article that is to be published in printed paper form for circulation by said publisher;

assigning, by said publisher, said at least one article with at least one unique tag prior to printing said article in printed paper form for circulation by said publisher;

publishing in circulation, by said publisher, both of said at least one article and its corresponding unique tag in printed paper form with its corresponding tag being printed in physical proximity to said article, said publisher also providing retrieval information indicative of a web site, an e-mail address and a telephone number for retrieval;

storing, by said publisher, said at least one article in an electronic database, said article being uniquely retrievable based on said corresponding unique tag;

connecting, by said publisher, said database to said Internet;

receiving, by said publisher, a request from an Internet client through one of said web site, said e-mail address and said telephone number indicated by said retrieval information, said request including said at least one tag and delivery information indicative of at least one of said Internet client's telephone number and said Internet client's e-mail address, said tag having been previously observed by said Internet client from said printed paper form in circulation, said Internet client having previously registered at least one of said Internet client's telephone number and said Internet client's e-mail address with said publisher;

said publisher authenticating said Internet client based on at least one of said Internet client's telephone number and said Internet client's e-mail address indicated by said request;

retrieving by said publisher from said database to locate said article in electronic form matching said at least one tag, upon authenticating said Internet client's request;

upon locating said article in electronic form from said database, said publisher electronically transmitting said article in electronic form to said Internet client's email address,

said method further comprising:

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upon pre-registering said Internet client, collecting and storing said Internet client's email address ~~of said Internet client~~ for delivery;

connecting said database to a telecommunication gateway, said gateway being adapted to transmit said request from an Internet client to said database through one of wireless and landline telephone telecommunication network;

upon authenticating said Internet client, sending said printed article in electronic form to said Internet client's email address ~~of said Internet client~~ previously collected.

20. (previously amended) The method of claim 19, further comprising the step of bundling additional information relevant to a subject matter of said article when electronically transmitting said article in portable electronic form to said Internet client, said relevant additional information being one of pre-supplied by another server as static information and supplied by another server in real-time.

21. (currently amended) The method of claim 20, further comprising the step of bundling additional relevant information based on ~~the~~ profile information supplied by said Internet client during said pre-registrating, said additional information being one of pre-supplied by another server as static information and supplied by another server in real-time.

22. (previously amended) The method of claim 21, further comprising the steps of bundling based on the profile information supplied by said Internet client and subject matter of said printed article, and collecting a fee by said publisher from said server for such bundling.

23. (canceled)

24. (previously amended) The method of claim 20, wherein the step of electronically transmitting said article in portable electronic form comprises sending to said email address supplied by said Internet client, wherein said request by said Internet client is in an e-mail with said at least one tag indicated in a subject field of the e-mail.

25. (canceled)

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26. (canceled)

27. (currently amended) The method of claim 22, wherein the step of assigning at least one tag to said article comprises:

assigning a default code, said default code being published with said article when printed in physical form for circulation;

assigning additional codes, comprising:

name of publication;

author's name;

date of publication;

at least a portion of said printed article's title.

28. (currently amended) A method of using the Internet to retrieve and handle a plurality of articles in electronic form from a plurality of publications which have been printed in paper form for circulation by at least one publisher, comprising:

a first step of printing an article in paper format for circulation by said publisher, comprising:

preparing said plurality of articles to be published in printed paper form for circulation by said publisher;

assigning, by said publisher, each of said plurality of articles to at least one unique tag prior to printing in printed paper form for circulation;

publishing in circulation, by said publisher, each of said plurality of articles in printed paper form with its corresponding tag also printed in physical proximity to each of said articles, said publisher also providing retrieval information indicative of a web site, an e-mail address and a telephone number for retrieval from an aggregator;

collecting said plurality of articles in portable electronic form;

storing said plurality of articles in at least one electronic database managed by said aggregator, each of said articles being uniquely retrievable based on said tag corresponding to each article;

connecting, by said aggregator, said at least one database to said Internet;
and

a second step of retrieving said article in portable electronic format, comprising:

receiving by said ~~third party~~ aggregator a request from an Internet client

through one of said web site, said e-mail address and said telephone number indicated by said retrieval information, said request specifying said at least one tag and ~~said~~ Internet client's delivery means of at least one of said Internet client's telephone number and said Internet client's e-mail address, said tag having been previously observed by said Internet client from said printed paper form in circulation, said Internet client having previously registered at least one of said Internet client's telephone number and said Internet client's e-mail address with said aggregator; said aggregator authenticating said Internet client based on at least one of said Internet client's telephone number and said Internet client's e-mail address indicated by said request;

retrieving from said at least one database to locate said article in portable electronic form matching said at least one tag by said aggregator, upon authenticating said Internet client's request;

upon locating said article in electronic form, said aggregator electronically sending said article in portable electronic form to said Internet client based on said Internet client's delivery means,

said method further comprising:

connecting said at least one database to a telecommunication gateway, said gateway being adapted to transmit a request with a tag from a telecommunication client to said database, said database being assigned said telephone number previously published by said publisher, said telecommunication client being assigned said Internet client's telephone number;

upon authenticating said request from said telecommunication client by recognizing said Internet client's telephone number, processing said request;

upon retrieving an article in portable electronic form matching said tag, transmitting said article in portable electronic form to said telecommunication client based on ~~specified~~ said Internet client's delivery means.

29. (previously amended) The method of claim 28, further comprising the step of bundling additional information relevant to a subject matter of said article with the electronic delivery of said article in portable electronic form to said Internet client, said relevant additional information being one of pre-supplied by another server as static information and supplied by another server in real-time.

Claim 30. (canceled).

Claims 31 – 38 (canceled).

Pursuant to MPEP 606.01 the **Title** is changed to read:

**-- METHOD OF USING THE INTERNET TO RETRIEVE AND HANDLE ARTICLES IN
ELECTRONIC FORM FROM PRINTED PUBLICATION WHICH HAVE BEEN
PRINTED IN PAPER FORM FOR CIRCULATION BY THE PUBLISHER --**

Reasons for allowance

Claims 19-22,24,27-29 are allowed

The following is an examiner's statement of reasons for indication of allowable subject matter: In view of applicant's arguments presented at page 15-20, the prior art of record does not disclose, make obvious, or otherwise suggest, "receiving, by said publisher, a request from an Internet client through one of said web site, said e-mail address and said telephone number indicated by said retrieval information, said request including said at least one tag and delivery information indicative of at least one of said Internet client's telephone number and said internet client's e-mail address, said tag having been previously observed by said Internet client from said printed paper form in circulation, said Internet client having previously registered at least one of said Internet client's telephone number and said Internet client's e-mail address with said publisher" in claim 19;

"receiving by said aggregator a request from an Internet client through one of said web site, said e-mail address and said telephone number indicated by said retrieval information, said request specifying said at least one tag and Internet client's delivery means of at least one of said Internet client's telephone number and said Internet client's e-mail address, said tag having been previously observed by said Internet client from said printed paper form in circulation, said Internet client having previously registered at least one of said Internet client's telephone number and said Internet client's e-mail address with said aggregator" in claim 28,

These features, together with the other limitations of the independent claims are novel and non-obvious over the prior art of record. The dependent claims 20-22,24, 27,29 being definite, enabled by the specification, and further limiting to the independent claims are also allowable.


The newly cited reference GB 2403568 is directed to electronic transfer of newspapers and magazines from publishers to end users, more specifically upon authentication, end user may select the publication and retail storage for collecting, storing and printing sales figures as detailed in Abstract, fig 5.

The newly cited reference "early user—system interaction for database selection in massive domain-specific online environments", issued to Jack G Conrad is directed to model for improved database selection that offers the user a key role in the discovery process, particularly searching large of collection of documents from database using queries to navigate to the most relevant data [see page 95, page 103-104].

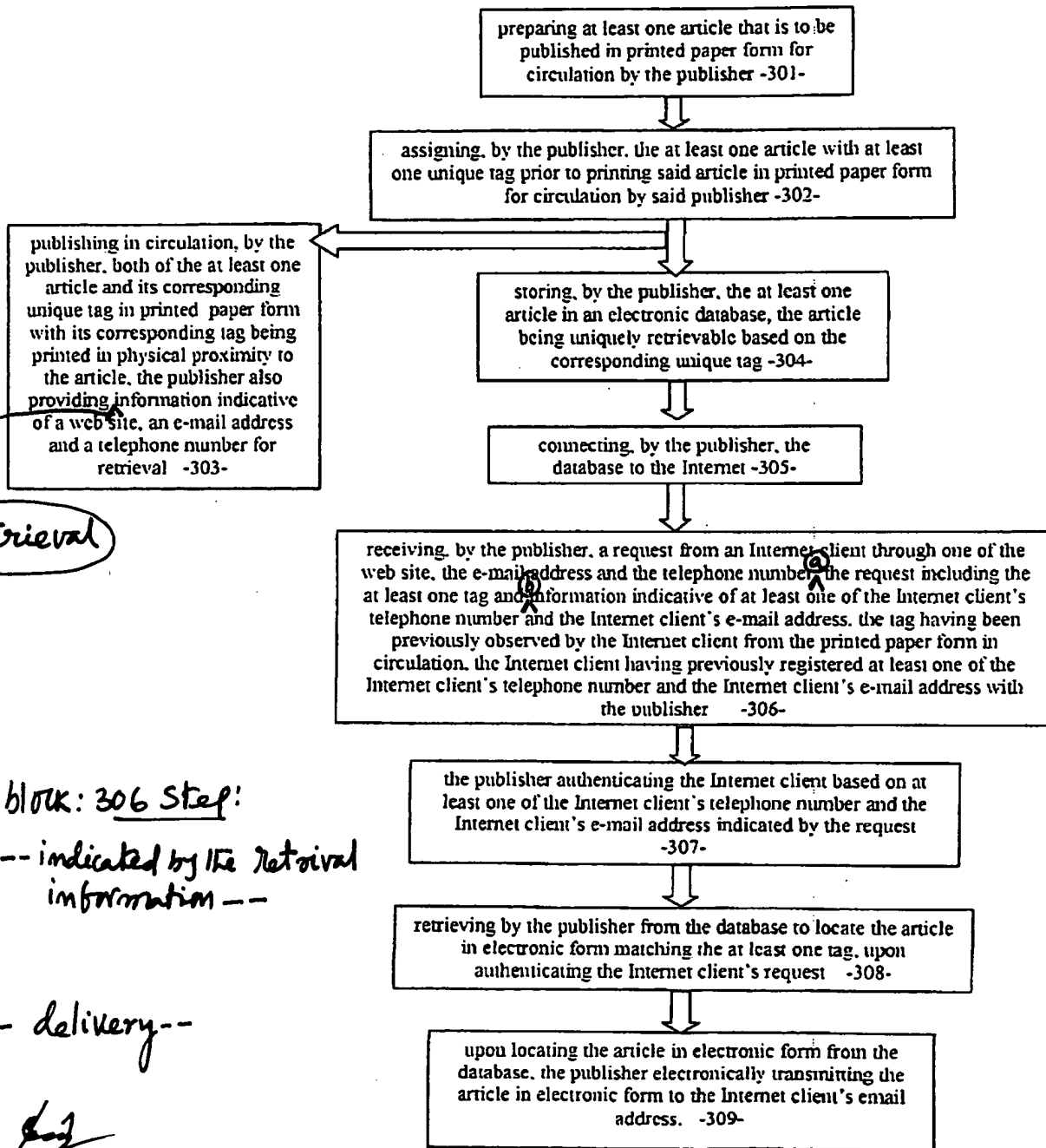
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain, T, can be reached on (571) 272-3978. The fax phone numbers for the organization where the application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

SC
Patent Examiner.
March 20, 2006.


SRIRAMA CHANNAVAJALA
PRIMARY EXAMINER

New Drawing 09/995,931



Line 2 block: 306 Step:
 @: add -- indicated by the retrieval information --

Line 3
 ⑥ add -- delivery --

3/17/2006

Figure 3
 EX: AMENED

New Drawing 09/995,931

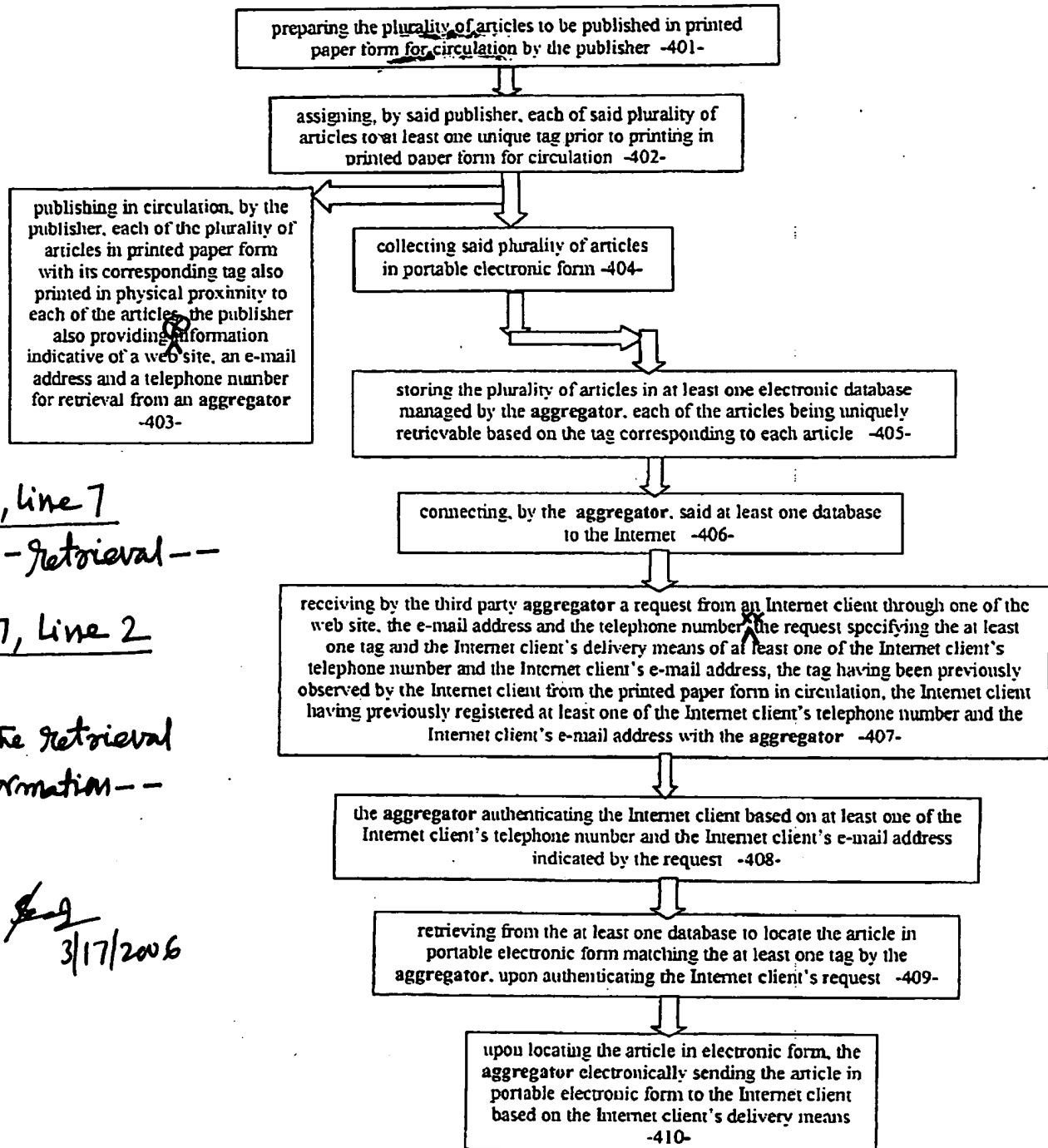


Figure 4

EX: AMENDED